

REMARKS

Claims 1-15, 17-20, 35-50, 52-56 and 58-62 are pending in the present application. Claims 1-15, 17-20, 35-50, 52-56 and 58-62 have been examined and are rejected. In the above amendments, claims 1, 12, 35, 52, 58 and 60 have been amended. Applicant believes that the present application is now in condition for allowance, which prompt and favorable action is respectfully requested. Support for Applicant's amendments is found in Applicant's as-filed specification in at least paragraphs [0010], [0012], [0026] and Applicant's Abstract. No new matter has been added.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on U.S. Patent No. 6,597,913, U.S. Publication No. 2002/0137521 and U.S. Publication No. 2002/0183039

Claims 1, 3-8, 12, 19, 35-39, 41, 45, 52, 58 and 62 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Natarajan (U.S. Patent No. 6,597,913) in view of Kim *et al* (U.S. Publication No. 2002/0137521) and further in view of Padgett *et al* (U.S. Publication No. 2002/0183039). Applicant respectfully traverses these rejections as hereinafter set forth.

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Additionally, there must be "a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicants' disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

The 35 U.S.C. § 103(a) obviousness rejections of claims 1, 3-8, 12, 19, 35-39, 41, 45, 52, 58 and 62 are improper because the elements for a *prima facie* case of obviousness are not met. Specifically, the rejection fails to meet the criterion that the prior art reference must teach or suggest all the claims limitations.

Regarding amended independent claim 1 with claims 3-8 and 10 depending therefrom, amended independent claim 12 with claim 19 depending therefrom, amended independent claim 35 with claims 36-39, 41 and 45 depending therefrom, and amended independent claims 52, 58 and 62, Applicant has amended independent claims 1, 12, 35, 52, 58 and 62 to include claim limitations not taught or suggested in the cited references. Specifically, Applicant's amended independent claims 1, 12, 35, 52, 58 and 62 each recite, *inter alia*, "each *service class corresponding to a particular type of data to be transmitted by the mobile station*" which is not taught or suggested in either Natarajan or Kim or Padgett.

Generally, Applicant's amendment independent claims recite a "service class corresponding to ... data to be *transmitted* by the mobile station" while the Office Action cites Padgett which contrastingly discloses a service class corresponding to data to be *received* by the mobile station. Specifically, the Office Action concedes, "the combination of Natarajan and Kim does not specifically disclose that each service class corresponding to a particular type of data." (Office Action, p. 3). The Office Action then alleges:

Padgett remedies the deficiencies of the combination of Natarajan and Kim by *disclosing* such limitation on Page 2, Paragraph 0018 through 0021, specifically Paragraph 0020; the *ALCM system at the base station receives an HSD service request and the request is granted based on service class of the request* and the rate, therefore, one of ordinary skill in the art would have recognized that service class corresponds to a particular type of data and the system would grant the data rate based on the type of data identified by the service class. (Office Action, pp. 3-4; emphasis added).

In support of Applicant's position that Padgett contrastingly teaches a service class corresponding to data to be *received* by the mobile station, Applicant provide the following quotations from Padgett. Specifically, Padgett teaches:

[T]he methods are applied to a *high-speed downlink (HSD)* which *provides high-rate transmission from the base station to the mobiles*. (Padgett, para. [0018], lns. 4-6; emphasis added).

[T]he *mobile sends an HSD service request* on the uplink ... [e]mbedded in that *request may be ... information about the message length and service class*. (Padgett, para. [0018], lns. 16-22; emphasis added).

When the request reaches the front of the queue, the *base station may transmit the HSD packet at the highest rate the mobile can reliably receive* (Padgett, para. [0018], lns. 25-27; emphasis added).

ALCM system 200 may include a processor 210 ... [p]rocessor 210 may receive request for service from mobile terminals (Padgett, para. [0019], lns. 3-5).

When incoming requests are received by processor 210 via port 212, processor 210 determines whether to grant the request based on instructions included in admission control module 230. For example, admission control module 230 may include admission criteria, such as ... service class of the request (Padgett, para. [0020], lns. 3-8).

The base station may then transmit the message to the mobile terminal. (Padgett, para. [0023], lns. 6-7).

Clearly, the “service class” as taught by Padgett corresponds to data to be *received* by the mobile station while Applicant’s claimed invention of amended independent claims 1, 12, 35, 52, 58 and 62 each recite a “service class corresponding to ... data to be *transmitted* by the mobile station.”

Therefore, since neither Natarajan nor Kim nor Padgett teach or suggest Applicant’s claimed invention including “each *service class corresponding to a particular type of data to be transmitted by the mobile station*,” these references, either individually or in any proper combination, cannot render obvious, under 35 U.S.C. §103, Applicant’s invention as presently claimed in amended independent claims 1, 12, 35, 52, 58 and 62. Accordingly, Applicant respectfully requests the rejection of presently amended independent claims 1, 12, 35, 52, 58 and 62 be withdrawn.

The nonobviousness of independent claim 1 precludes a rejection of claims 3-8 and 10 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), see also MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claim 1 and claims 3-8 and 10 which depend therefrom.

The nonobviousness of independent claim 12 precludes a rejection of claim 19 which depends therefrom because a dependent claim is obvious only if the independent claim from

which it depends is obvious. See In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), see also MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claim 12 and claim 19 which depends therefrom.

The nonobviousness of independent claim 35 precludes a rejection of claims 36-39, 41 and 45 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), see also MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claim 35 and claims 36-39, 41 and 45 which depend therefrom.

Obviousness Rejection Based on U.S. Patent No. 6,597,913, U.S. Publication No. 2002/0137521, U.S. Publication No. 2002/0183039 and U.S. Publication No. 2004/0228349

Claims 2, 9, 11, 13-15, 17, 18, 20, 40, 42-44, 46-50, 53-56 and 59-61 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Natarajan in view of Kim and further in view of Padgett and yet further in view of Vrzic *et al* (U.S. Publication No. 2004/0228349). Applicant respectfully traverses these rejections as hereinafter set forth.

The nonobviousness of independent claim 1 precludes a rejection of claims 2, 9 and 11 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), see also MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claim 1 and claims 2, 9 and 11 which depend therefrom.

The nonobviousness of independent claim 12 precludes a rejection of claims 13-15, 17, 18 and 20 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), see also MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claim 12 and claims 13-15, 17, 18 and 20 which depend therefrom.

The nonobviousness of independent claim 35 precludes a rejection of claims 40, 42-44 and 46-50 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claim 35 and claims 40, 42-44 and 46-50 which depend therefrom.

The nonobviousness of independent claim 52 precludes a rejection of claims 53-56 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claim 52 and claims 53-56 which depend therefrom.

The nonobviousness of independent claim 58 precludes a rejection of claims 59-61 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claim 58 and claims 59-61 which depend therefrom.

ENTRY OF AMENDMENTS

The proposed amendments to claims 1, 12, 35, 52, 58 and 62 above should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application. Further, the amendments do not raise new issues or require a further search. Finally, if the Examiner determines that the amendments do not place the application in condition for allowance, entry is respectfully requested upon filing of a Notice of Appeal herein.

REQUEST FOR ALLOWANCE

In view of the foregoing, Applicant respectfully submits that all of the pending claims in the application are patentable. Accordingly, reconsideration and allowance of this application are earnestly solicited. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

Respectfully submitted,

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